REMARKS

Request for withdrawal of finality of the current office action

The Examiner has submitted a new reference (Sitrick) and argued new grounds of rejection for claims 27-30 in the current office action. These new grounds of rejection were not necessitated by an amendment, as claims 27-30 were previously amended to correct only certain informalities. Since the correction of the informalities did not add any new limitations or elements to these claims, the Examiner could have presented the Sitrick reference and new grounds of rejection for claims 27-30 in the previous Office Action. Accordingly, the Applicant submits that the finality of this Office Action is premature under MPEP 706.07(a), and requests that the finality be withdrawn under MPEP 706.07(d).

Claim Rejections – 35 USC §112

Claims 1, 3-10 and 16 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 16 are amended to overcome the rejection. Support for the amendments may be found, e.g., at page 8, line 31; and page 10, line 23.

Claim Rejections – 35 USC §103

Claims 1, 3-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ito, U.S. Patent Publication No. 2003/0121401 (hereinafter "Ito") in view of Sitrick, U.S. Patent No. 6,084,168 (hereinafter "Sitrick")

Claim 1 is amended to recite a musical apparatus that can be operatively coupled to a second musical apparatus including an audio score mixing mechanism. Ito only discloses a system in which only one apparatus on the network has a mixer. The Examiner appears to acknowledge, while rejecting claims 11-16, 21-24, and 27-31, that Ito/Sitrick combination does not teach the limitation. The Examiner, however, alleges that it would have been obvious to adapt the Ito/Sitrick combination so that each device would have a mixing mechanism, as it has been held that mere duplication of working parts does not constitute nonobviousness and refers to MPEP 2144.04. The Examiner has essentially extracted a "*per se*" rule of obviousness from *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), which is referred to in the relevant section of MPEP 2144.04.

However, The Court Of Appeals For The Federal Circuit has held that the precedents do not establish any *per se* rules of obviousness, and that reliance on *per se* rules of obviousness is legally incorrect and must cease. *In re Ochiai*, 37 USPQ2d 1127, 1133 (CAFC 1995). Instead, section 103 requires a fact-intensive comparison of the claimed invention with the teachings of the prior art. In the present application, the prior art provides no suggestion or motivation to include a mixing mechanism in a plurality of operatively coupled musical apparatus. Thus, claim 1 is patentable over the Ito/Sitrick combination. Moreover, the limitation makes possible novel and nonobvious features having advantages over the prior art, some of which are discussed in the specification at page 7, lines 10-12. The Examiner has not identified analogous features in the prior art. Therefore, examiner has not made out a *prima facie* case of obviousness under 35 USC 103(a) and for at least these reasons, claim 1 should be allowable, along with its dependent claims.

Independent claims 11, 17, 21, 25, and 27 include similar limitations and for at least the reasons discussed above, a *prima facie* case of obviousness has not been established and hence, these claims should be allowable along with associated dependent claims.

Conclusion

Applicant requests reconsideration in view of the foregoing remarks. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case. Applicant's representative can frequently be reached at (503) 880-3613 outside of normal office hours.

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Respectfully submitted,

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